

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 57

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

DEC 23 2003

Ex parte TETSURO MOTOYAMA

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2002-0867
Application No. 08/738,659

HEARD: October 21, 2003

Before BARRETT, LEVY, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87, which are all the claims remaining in the application.

We affirm-in-part, and enter a new ground of rejection in accordance with 37 CFR § 1.196(b).

BACKGROUND

The invention is directed to a method and system for communications, using electronic mail, between a monitoring device and a device monitored by the monitoring device. Claim 10 is reproduced below.

10. A method for communicating between a monitored device and a monitoring device, comprising the steps of:

determining information to be transmitted by the monitoring device to the monitored device, the information including a request for a status of the monitored device determined using sensors within the monitored device; and

transmitting the information through electronic mail from the monitoring device to the monitored device.

The examiner relies on the following references:

Banno et al. (Banno)	4,876,606	Oct. 24, 1989
Kraslavsky et al. (Kraslavsky)	5,537,626	Jul. 16, 1996 (filed Feb. 13, 1995)
Cohn et al. (Cohn)	5,740,231	Apr. 14, 1998 (filed Sep. 16, 1994)

Claims 10, 12-19, 36, 38-44, 52-61, and 68-87 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Kraslavsky and Cohn.¹

We refer to the Rejection (Paper No. 41; mailed Jul. 30, 2001) and the Examiner's Answer (Paper No. 47; mailed Nov. 19, 2001) for a statement of the

¹ Banno, relied upon as showing an inherent feature of Kraslavsky, should have been included in the initial statement of the rejection as to the relevant claims. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection.").

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examiner's position and to the Brief (Paper No. 45; filed Aug. 29, 2001) and the Reply Brief (Paper No. 48; filed Jan. 14, 2002) for appellant's position with respect to the claims which stand rejected.²

OPINION

Section 103 rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87 over Kraslavsky and Cohn

The statement of the rejection of claims 10, 12-19, 36, 38-44, 52-61, and 68-87 under 35 U.S.C. § 103 as being unpatentable over Kraslavsky and Cohn is set forth in the Answer. Since Kraslavsky is deemed to not explicitly teach that messages are transmitted as Internet electronic mail messages, the rejection adds Cohn to show suggestion to use an Internet electronic mail message format. (Answer at 5.)

A. Claims 10, 16, 36, 42, 74, 78, 82, and 86

Instant claims 10, 16, 36, 42, 74, 78, 82, and 86 do not require transmission of Internet messages, nor sending messages in an Internet format. We enter new

² The file contains a paper styled as a "Final Rejection," purportedly "Paper No. 46," which further purports to be in response to appellant's paper filed August 29, 2001 (i.e., the Brief). The final page of said Paper No. 46 contains a printed date of December 30, 2001. However, the paper is not stamped with a mailing date; it is thus unclear whether a copy of the paper was mailed to appellant. Moreover, the paper does not appear to withdraw the earlier rejection and reopen prosecution. Further, another "Paper No. 46," mailed November 19, 2001, documents consideration of an Information Disclosure Statement submitted by appellant. In any event, the appeal is from the rejection mailed July 30, 2001. We have jurisdiction because the claims have been twice rejected as of the date of the rejection under appeal.

grounds of rejection against these claims, infra. Since Kraslavsky discloses all that is required by the claims, we will sustain the rejection of these claims under 35 U.S.C. § 103.

B. Claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87

The remainder of the claims require, as set forth in broadest claims 54, 68, 69, 70, and 71 of the group, transmitting an Internet electronic mail message over the Internet, or outside of a local network. We interpret transmission of the Internet electronic mail message, as claimed, as requiring more than the electronic message transmission as disclosed by Kraslavsky. We note, in particular, appellant's description of Internet mail communications at page 7 of the specification.

In response to the section 103 rejection over Kraslavsky and Cohn, appellant argues, inter alia, that at the time of invention email (or Internet electronic mail transmission, as required by the instant group of claims), was considered to lack interactivity and rapid communication features. Appellant relies on an expert's declaration (submitted May 11, 2001) as support for the view. Appellant posits that, as a consequence, the artisan would not have thought to modify the Kraslavsky system. (Brief at 8-9.)

We are substantially in agreement with the examiner's position (e.g., Answer at 11-12). Neither the briefs nor the declaration point to any express support for the

position in the references. Neither the briefs nor the declaration rely on any other factual support tending to substantiate appellant's position.

However, we agree with appellant, as developed in the briefs and the declaration, that the combination of Kraslavsky and Cohn would not have suggested transmission of Internet electronic communications between a monitored and a monitored device as claimed. We disagree with appellant to the extent that appellant may hold that neither reference discloses use of the Internet (e.g. declaration at 10). Cohn teaches a message format having an "Internet style address" (col. 15, l. 65 - col. 16, l. 36) that facilitates communications with messaging systems such as Internet service providers (col. 15, ll. 21-32).

However, as pointed out at page 6, paragraph 11 of the declaration, all of the messages contemplated by Cohn originate from a human and are intended for a human recipient. Kraslavsky deals with device status monitoring on a LAN or on one or more LANs in a wide-area network (WAN), as described at column 7, line 38 et seq. of the reference. We find no disclosure or suggestion in Kraslavsky or Cohn, nor in any combination of teachings thereof, for transmitting Internet electronic mail messages between machines, for monitoring devices, as claimed by appellant. The Banno reference, applied by the examiner to show an asserted inherent feature of Kraslavsky, fails to remedy the deficiency of Kraslavsky and Cohn.

We thus do not sustain the Section 103 rejection of claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87.

New Ground of Rejection -- 37 CFR § 1.196(b)

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 1.196(b): Claims 10, 16, 36, 42, 74, 78, 82, and 86 are rejected under 35 U.S.C. § 102(e)(2) as being anticipated by Kraslavsky.

Independent claims 10, 16, 36, and 42 recite transmitting information through "electronic mail." The instant specification does not set forth any particular definition for the term. We are thus faced with the problem of determining the metes and bounds of the recitation; a problem that we addressed in a decision in an earlier appeal in a related application. In particular, in that application (S.N. 08/738,461; Appeal No. 1999-2767), we determined that the term is broad in scope. We reproduce below the pertinent section from the earlier decision, which applied the claimed "electronic mail message" to the Kraslavsky reference.

A section 103 analysis begins with a key legal question -- what is the invention claimed? Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). At the oral hearing, appellant's counsel confirmed that Kraslavsky discloses a process that meets all requirements of instant claim 88, with one exception argued by appellant -- although the reference discloses receiving and analyzing electronic messages, the messages are not deemed to be electronic "mail" messages. Determining the metes and bounds of the recitation "electronic mail message" is thus a material inquiry in proper interpretation of claim 88.

Counsel for appellant conceded that the instant specification does not provide a definition for the relevant term. However, counsel submitted that the term is well-known in the art, and that a formal definition may be found by reference to technical dictionaries.

The McGraw-Hill Dictionary of Scientific and Technical Terms, (5th ed. 1994), at page 663, defines electronic mail as "[t]he electronic transmission of letters, messages, and memos through a communications

network.” The New IEEE Standard Dictionary of Electrical and Electronics Terms (5th ed. 1993), at page 426, defines electronic mail as “[t]he generation, transmission, and display of correspondence and documents by electronic means.” The Microsoft Press Computer Dictionary (2nd ed. 1994), at page 143, defines electronic mail as “[t]he transmission of messages over a communications network.” [Footnote omitted.] The Microsoft Press dictionary entry for the relevant term goes on to describe ways in which electronic mail may be used, but does not restrict “electronic mail” to any particular format or protocol, nor to any particular communications network equipment.

We acknowledge that there may be other definitions in other technical dictionaries suggesting a narrower meaning for “electronic mail” than those definitions we have noted. However, that narrower definitions might be found is immaterial in the present inquiry. Claims are to be given their broadest reasonable interpretation during prosecution. See In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” Zletz, 893 F.2d at 321, 13 USPQ2d at 1322.

In view of the above-noted technical dictionary definitions, we fail to see how the broadest reasonable interpretation of “electronic mail message” as presented in instant claim 88 precludes the electronic communication of files over the local area network (LAN) disclosed by Kraslavsky.

Appellant’s specification (at 9-10) provides a formal definition of “connectionless-mode transmission,” and suggests that Internet electronic mail systems may provide a means for connectionless-mode of communication (at 18). However, the artisan knew that communication across a LAN as disclosed by Kraslavsky is also a form of connectionless-mode transmission. At the hardware level, each EtherNet board on the LAN has a unique Media Access Control (MAC) address. Col. 9, ll. 25-34. Data are transferred in frame packets comprised of the destination address, the source address, and a data section. Col. 28, ll. 23-35; Fig. 9. There is no direct connection between a source and destination of data transferred on the network.

In Kraslavsky, by means of PC 14 the network administrator may perform extensive monitoring of printer 4. Col. 6, l. 45 - col. 7, l. 19. However, Kraslavsky discloses that any PC on the network (Figure 1) may

request the status -- i.e., monitor -- and utilize the services of printer 4 via the network and the network expansion board (NEB) 2 within printer 4. Further, printer 4 analyzes a received print job and prints the received data accordingly. Col. 8, l. 24 - col. 9, l. 4.

We find that printer 4 receiving, analyzing, and printing a text document from a PC on the network meets all the requirements of instant claim 88.

At the oral hearing, counsel for appellant also offered an informal definition of "electronic mail message," along the lines that such a message requires a subject line and is intended as communication between human beings. However, the technical dictionary definitions of the relevant term do not require so narrow an interpretation. Moreover, as disclosed and claimed, the "electronic mail message" is intended for machine processing -- counsel emphasized that when read in light of the specification, claim 88 requires that a machine, rather than a human being, analyze the electronic mail message. The requirements of claim 88 are thus contrary to an informal or functional definition of "electronic mail message" that requires that the message be intended for, or readable by, human beings.³

Since we find all requirements of claim 88 met within the four corners of the Kraslavsky reference, we consider Cohn to be merely cumulative in the section 103 rejection. We also refer to the Kraslavsky reference alone for the requirements that the electronic mail message is received through a LAN (claim 108/88) and without using a telephone line (claim 109/108/88). We thus find the subject matter of all representative claims to be anticipated by Kraslavsky.

We sustain the rejection of claims 88-139 under 35 U.S.C. § 103. A finding of anticipation means that the claims are also obvious under 35 U.S.C. § 103; anticipation is the epitome of obviousness. See, e.g., Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548, 220 USPQ 193,

³ Although not shown in the prior art before us, counsel was also asked what language in claim 88 might be thought to distinguish over a computer workstation causing an icon (e.g., an envelope icon) to appear on the computer display screen to notify one that an e-mail (intended for a human being) has been received. Counsel argued that a computer display screen (e.g., a CRT) would not be considered a "business office device," referring to the paragraph bridging pages 14 and 15 of the specification. However: (1) appellant's list of "business office machines" is clearly illustrative, rather than exhaustive; and (2) a computer display screen is not a "general purpose computer." Moreover, it is far from apparent why a printer can be considered a "business office device" but a computer display screen cannot. Business-related text or graphics is often viewed on a display before printing.

198 (Fed. Cir. 1983); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

Evidence of secondary considerations such as “long-felt but unresolved need” is irrelevant when the invention lacks novelty. See, e.g., In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974) (citing In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973)). Moreover, evidence submitted to show nonobviousness is not relevant or material when an invention is anticipated. We thus will not consider or further address appellant’s reliance (e.g., Brief at 5) on declarations submitted to show nonobviousness of the invention.

In the instant case, claim 10 recites a method for communicating between a monitored device and a monitoring device, comprising determining information to be transmitted by the monitoring device to the monitored device, the information including a request for status of the monitored device determined using sensors within the monitored device.

Kraslavsky discloses a printer 4 (Fig. 1) on a local area network (LAN) 6. The printer includes a network expansion board (NEB) interfacing the printer to the LAN. The network may use network software, such as Unix software, to effect communication over the various network members. Col. 4, ll. 1-58. With use of the NEB, “verbose amounts” of status information may be provided from the printer 4 to the LAN, including more than the simple “out of paper” and “off line” status messages that prior systems allowed. Col. 6, ll. 18-62.

Software on the network administrator’s PC 14 allows request of status information from the printer. Col. 14, ll. 27-48. Software at the remote printer outputs

the device status information in response. Col. 18, ll. 34-59. The communications may use TCP/IP protocol, if the LAN is running a Unix operating system. Col. 18, l. 60 - col. 19, l. 4. As shown in Figure 5C, the network administrator may request detailed status information from the printer (or other peripheral device on the network, if equipped with an NEB), the status information being transmitted from the printer through the LAN to the administrator's PC 14. Col. 20, l. 49 - col. 21, l. 15.

Kraslavsky thus discloses a monitoring device (PC 14) which determines information to be transmitted to a monitored device (printer 4), the information including a request for status of the printer determined using sensors within the printer, such as sensors that ascertain if the printer is off-line or out of paper.

Claim 10 further requires that the information from the monitoring device to the monitored device (e.g., the request for status) be transmitted through "electronic mail." In view of the broadest reasonable interpretation of "electronic mail," as we discussed in the above-noted prior decision -- "electronic mail" requires "the transmission of messages over a communications network" -- we find no difference between the relevant claim 10 requirement and the transmission of the PC 14 message to printer 4, over the LAN 6 using TCP/IP protocol within a Unix operating system, as disclosed by Kraslavsky.

Instant claim 74, depending from claim 10, requires that the transmitting step comprises transmitting the electronic mail message "without using a telephone line."

Kraslavsky, disclosing transmission of the message over a LAN, is squarely within the terms of the negative limitation of claim 74.

We have addressed the substantive limitations of independent claim 10 and dependent claim 74. The remainder of the claims (16, 36, 42, 78, 82, and 86) are also anticipated, reciting limitations similar in scope to claims 10 and 74.

Declaration submitted at oral hearing

In anticipation that we might enter new grounds of rejection over Kraslavsky, based on a broader interpretation of "electronic mail," as we did in the earlier appeal, appellant's representative presented copies of an expert's declaration (37 CFR § 1.132) at the oral hearing.⁴ The declarant states therein (¶ 9) that "[i]t is my understanding that the meaning of electronic mail may be at issue."

The declarant sets forth the opinion (¶ 12) that the artisan would have considered, at the time of invention, the basic features of electronic mail to be that (1) electronic mail is used to send messages between electronic devices, (2) electronic mail is sent through or received from an electronic mail box or e-mail account, and (3) electronic mail is sent through or received from a host computer, sometimes referred to as a "mail server."

⁴ A copy of the declaration has been entered in the instant file wrapper as Paper No. 56.

As factual support for the opinion, the declaration provides, and references, a portion (six pages) of a text published in 1995. As set forth on the second page of the provided copies, the text, "At ease with e-mail: A handbook on using electronic mail for NGOs in developing countries," prepared by the United Nations Non-Governmental Liaison Service and the Friedrich Ebert Foundation (New York Office), is "for beginners." Our review of the reference confirms that the text is directed to end users of electronic communications systems, rather than to designers of the systems. The reference thus has little relevance in showing the artisan's understanding of the relevant term.

We acknowledge that the most common conception of electronic mail may have required the three features set forth in the declaration, even with respect to one skilled in the art. The most common definition of "electronic mail" is not at issue. Rather, the inquiry is with respect to the metes and bounds of the subject matter that may be included within the scope of the term, under the broadest reasonable interpretation as understood by the artisan at the time of invention.

The declaration also refers to the instant disclosure, at page 15, which relates registering the name and address of the monitored device in a mail server, "for example," which will send and receive electronic mail for the network to which the mail server is connected. The claims that we reject as anticipated by Kraslavsky, however, say nothing about a mail server, nor about using a mail server.

Our evaluation of the declaration does not convince us that the broadest reasonable interpretation of "electronic mail" requires an interpretation that excludes the electronic communications described by Kraslavsky. While the expert's declaration provides evidence entitled to our careful consideration, the declaration does not attempt to harmonize -- nor does it even address -- the evidence that supports a more expansive definition for the term; e.g., the technical dictionary definitions we have previously noted.

Naugle

U.S. Patent 5,715,393 ("Naugle,") filed Jun. 21, 1995, issued Feb. 3, 1998, has been cited as a reference by appellant during prosecution of the instant application. (See Paper No. 39; filed May 23, 2001.) We will not take the filing of the IDS as an un rebuttable admission that Naugle is prior art with respect to appellant. However, in the event of further prosecution, appellant should clarify the status of Naugle with respect to this application.

Moreover, although Naugle is not a reference under 35 U.S.C. § 102, we note that the patent is a continuation-in-part of an application filed August 16, 1993, prior to appellant's claimed priority date of June 5, 1995. The earlier-filed application (106,733), according to USPTO records, was abandoned as part of a file-wrapper-continuation of the application that matured into the Naugle patent.

For reasons set forth in In re Wertheim, 646 F.2d 527, 531-39, 209 USPQ 554, 559-66 (CCPA 1981), when a patent disclosure relies on one or more continuation-in-part applications in a chain of priority under 35 U.S.C. § 120, there must be a determination with respect to what effect the presentation of new matter has in the patent's chain of priority -- whether the patent disclosure represents "secret prior art" as to the application at issue, and thus whether or not effective as a reference.

If...[the USPTO] wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

Wertheim, 646 F.2d at 537, 209 USPQ at 564.

The determinative question is whether the invention claimed in Naugle finds a supporting disclosure, in the earlier-filed application in question, in compliance with section 112, as required by section 120, so as to entitle that invention as "prior art" to the filing date of the patent's earlier-filed application. See id. The only date a patent has under section 102(e)(2) is the filing date of the application on which the patent issued. "Any earlier U.S. filing date for the patent necessarily depends on further compliance with §§ 120 and 112." Wertheim, 646 F.2d at 538, 209 USPQ at 565.

Naugle, if considered a reference, would appear to be material to patentability of instant claims 10, 16, 36, 42, 74, 78, 82, and 86. For that reason, if the examiner has not done so, the examiner should inspect the file wrapper of the Naugle patent and

determine if the earlier-filed application contains §§ 120/112 support for the invention claimed in the patent.⁵

The Naugle patent describes a method for communicating between a monitored device and a monitoring device, comprising the steps set forth by instant (representative) claim 10.

Naugle describes, at column 2 of the reference, computers connected in a network 37 (Fig. 1) using TCP/IP network protocol. At a predetermined time monitor computer 11 sends a network verify command to a target computer 12 (Fig. 2). Next, a test of the email capability of the target computer is performed to ensure that email service in the target computer is operational. Col. 3, ll. 7-10. Naugle describes using the "Sendmail" software package, which is standard in the "Unix-like" operating systems of the respective computers. Id. at ll. 21-30.

Naugle further describes that, after the monitoring device (monitor computer 11) receives an email reply message from the monitored device (target computer 12), the monitor computer determines information to be sent via an email message to the target computer. The monitor computer sends a message requesting status information (col. 4, ll. 9-35), and the target computer transmits to the monitor computer a message containing the requested status information (col. 5, ll. 22-26). Status of the target

⁵ If rejection over Naugle is indicated, to make a *prima facie* case for unpatentability -- without relying on an admission by appellant that Naugle is prior art -- any statement of rejection must include findings with respect to how the earlier-filed application contains §§ 120/112 support for the invention claimed in Naugle.

computer may be determined using sensors within the target -- e.g., sensors determining disk space availability in the target (entries in table bridging cols. 3, 4 and 4, 5, and text at col. 5, ll. 35-42).

CONCLUSION

We have sustained the rejection of claims 10, 16, 36, 42, 74, 78, 82, and 86 under 35 U.S.C. § 103, but have not sustained the rejection of claims 12-15, 17-19, 38-41, 43, 44, 52-61, 68-73, 75-77, 79-81, 83-85, and 87. The examiner's decision in rejecting claims 10, 12-19, 36, 38-44, 52-61, and 68-87 is thus affirmed-in-part.

Claims 10, 16, 36, 42, 74, 78, 82, and 86 are newly rejected by us under 35 U.S.C. § 102.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claim:

(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

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(2) Request that the application be reheard under § 1.197(b) by the Board of
Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART -- 37 CFR 1.196(b)


LEE E. BARRETT
Administrative Patent Judge


STUART S. LEVY
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge

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Application No. 08/738,659

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